

## **REMARKS**

### **1. Introduction**

In the Office Action mailed November 15, 2005, the Examiner rejected (i) claims 1, 2 and 9-11 under 35 U.S.C. 102(b) as being anticipated by Mimura (U.S. Application No. 2002/0027891), (ii) claim 3 under 35 U.S.C. 103(a) as being unpatentable over Mimura in view of Matsumoto (U.S. Application No. 2002/0123628), (iii) claim 4 under 35 U.S.C. 103(a) as being unpatentable over Mimura in view of Ho (U.S. Patent No. 5,943,621), (iv) claims 5-8, 12 and 13 under 35 U.S.C. 103(a) as being unpatentable over Mimura in view of Dorenbosh (U.S. Application No. 2004/0264414), (v) claims 14-16 and 18-24 under 35 U.S.C. 103(a) as being unpatentable over Dorenbosh in view of Mimura, and (vi) claim 17 under U.S.C. 103(a) as being unpatentable over Dorenbosh in view of Mimura and in further view of Sorenson et al (U.S. Patent No. 6,463,298).

The Examiner also rejected claims 18 and 19 under 35 U.S.C. § 112, ¶ 2, as being indefinite. In response, Applicants have amended claims 18 and 19 to reflect that they are dependent on claim 14, rather than claim 13.

Applicants request reconsideration and allowance of the claims, as amended, for the reasons set forth below.

### **2. Response to Claim Rejections**

#### **a. Claims 1-10, 12, and 13**

Of these claims, claim 1 is independent, and the remainder are dependent. The Examiner has rejected claim 1 under § 102(b) as being unpatentable over Mimura. In response, Applicants have amended claim 1 to recite (i) “wherein the first radio network is a wireless wide area

network (WWAN),” and (ii) “wherein the predetermined action comprises checking for availability of a wireless local area network (WLAN).” These amendments are supported in Applicants’ Specification at various places, e.g., at page 5, lines 2-20. Applicants submit that these amendments clearly distinguish claim 1 over Mimura, as set forth below.

The Examiner has alleged that Mimura teaches detecting that a mobile station communicating with a first radio network has changed location and thereafter stopped moving in Figure 12 (Office Action, page 3). In fact, however, Mimura teaches that the reception level of the pilot channel from the base station increases in the mobile station when the mobile station moves from one position to another (Figure 12; paragraph 0126). Mimura does not teach that the reception level thereafter stops increasing, i.e., Mimura does not specify that the mobile station has thereafter stopped moving. Thus, Mimura does teach detecting that the mobile station has changed location *and thereafter stopped moving*.

In addition, Mimura does not teach checking for availability of a *wireless local area network* (WLAN) in response to the function of detection. Indeed, Mimura does not mention a WLAN at all.

Accordingly, Applicants submit that claim 1 is allowable over Mimura for at least the foregoing reasons. Applicants further submit that claims 2-10 and 12-13 are allowable for at least the reason that the claims are dependent on an allowable claim.

**b. Claims 14-19**

Of these claims, claim 14 is independent, and the remainder are dependent. The Examiner has rejected claim 14 under § 103(a) as being unpatentable over Dorenbosh in view of Mimura. In response, Applicants have amended claim 14 to recite the functions of (i) determining that a mobile station “communicating with a wireless wide area network (WWAN)”

has changed location and thereafter stopped moving, (ii) enabling a “wireless local area network (WLAN)” radio in the mobile station, wherein the mobile station uses the “WLAN” radio to communicate with a “WLAN,” and (iii) attempting to communicate with the “WLAN.” Applicants submit that these amendments clearly distinguish claim 14 over the Dorenbosh/Mimura combination, as set forth below.

The Examiner has acknowledged that Dorenbosh does not teach detecting that the mobile station has stopped moving (Office Action, page 8). Instead, the Examiner has alleged that Mimura teaches a mobile station that moves from position I and stops at position II (Office Action, page 8). However, as noted above, Mimura does not teach that the mobile station *stops* at position II. What Mimura actually teaches is detecting *movement* of the mobile station, i.e., detecting that the reception level of the pilot channel is increasing (paragraph 0126), not detecting that the mobile station has *stopped*.

Furthermore, in order to establish a *prima facie* case of obviousness based on a combination of Dorenbosh and Mimura, the Examiner must show some suggestion or motivation to combine the reference teachings, and the teaching or suggestion to make the claimed combination must be found in the prior art. MPEP § 2143. In this case, the Examiner has alleged “that it would have been obvious to modify Dorenbosh with the mobile station to register with the WLAN when the mobile station has roamed within a building, as taught by Mimura” (Office Action, page 8). However, Mimura does not teach that a mobile station has roamed within a building. Because the teaching or suggestion to make the claimed combination of Dorenbosh and Mimura must be found in the prior art, and it is not, the Examiner has failed to establish a *prima facie* case of obviousness.

Accordingly, Applicants submit that claim 14 is allowable over the combination of Dorenbosh and Mimura for at least the foregoing reasons. Applicants further submit that claims 15-19 are allowable for at least the reason that the claims are dependent on an allowable claim.

**c. Claims 20-24**

Of these claims, claim 20 is independent, and the remainder are dependent. The Examiner has rejected claim 20 under § 103(a) as being unpatentable over Dorenbosh in view of Mimura.

Claim 20 recites a mobile station that comprises logic to determine that a mobile station has changed location and thereafter stopped moving. As described above, Mimura does not teach detecting that the mobile station has changed location *and thereafter stopped moving*. Instead, Mimura teaches detecting that a mobile station has moved from position I to position II (paragraph 0126), not that the mobile station has thereafter stopped moving. Thus, Mimura does not teach logic in the mobile station to determine that the mobile station has changed location and thereafter stopped moving.

Furthermore, the Examiner has acknowledged that Dorenbosh does not teach detecting that the mobile station has stopped moving (Office Action, page 9). Thus, the combination of Dorenbosh and Mimura does not teach logic in the mobile station to determine that the mobile station has changed location *and thereafter stopped moving*.

Accordingly, Applicants submit that claim 20 is allowable over Mimura and Dorenbosh for at least the foregoing reasons. Applicants further submit that claims 21-24 are allowable for at least the reason that the claims are dependent on an allowable claim.

3. **Conclusion**

Applicants submit that the present application is in condition for allowance, and notice to that effect is hereby requested. Should the Examiner feel that further dialog would advance the subject application to issuance, the Examiner is invited to telephone the undersigned at any time at (312) 913-0001.

Respectfully submitted,

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